

REMARKS/ARGUMENTS

The non-final Office Action of August 7, 2008, has been reviewed and these remarks are responsive thereto. Claims 52 and 53 have been amended, no claims have been canceled, and new claims 62 and 63 have been added. No new matter has been introduced. Claims 2-6, 8-17, 20-24, 26-31, 33-41, and 43-63 are pending in this application upon entry of the present amendment. Reconsideration and allowance are respectfully requested.

Regarding Claims 54, 55, and 58

Preliminarily, as previously noted by Applicant in the Request for Reconsideration dated April 23, 2008, the Office Action Summary indicates that claims 54 and 55 stand rejected but does not include a substantive rejection of these claims based on any of the cited references. Applicant has previously argued that the features of claims 54 and 55 are patentable, and continues to believe that these claims are allowable over the cited references.

With respect to independent claim 58, the Office Action Summary indicates that this claim stands rejected but it is unclear from the Office Action which reference or combination of references allegedly teaches the features of this independent claim. Office Action, page 24. Applicant respectfully requests that a subsequent office action that substantively addresses claim 58 identify with specificity which references and sections thereof are being relied upon to support the rejection.

Additionally, because the Office Action has not indicated where in the cited references features of claims 54, 55, and 58 are allegedly taught, Applicant requests again that a subsequent office action that substantively addresses these claims should also be non-final to provide Applicant an opportunity to respond to such rejections when first presented.

Rejections Under 35 U.S.C. § 103

Claims 8, 11-13, 21, 24, 44, 50-53, and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,822,663 (Wang). Claims 2-6, 9-10, 14, 17, 20, 22, 23, 26, 29-31, 33-41, 43, 45, 57, and 59-61 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,654,814 (Britton). Claims 15 and 46-49 stand rejected under U.S.C. 103(a) as being unpatentable over Wang, in view of Britton, and further in view of US

Patent Publication No. 2002/0091738 (Rohrbaugh). Claim 16 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of U.S. Patent No. 6,523,040 (Lo). Claims 27 and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Rohrbaugh. Applicant respectfully traverses for at least the following reasons.

Independent Claims 50, 51, 56, and 58

Claim 50 recites, in part, receiving device-independent content responsive to a content request, wherein the “device-independent content compris[es] markup language identifying one or more device feature values.” The Office Action acknowledges on page 3 that Wang does not disclose requesting or receiving content comprising markup language identifying device feature values, but alleges that this modification of Wang would have been obvious “in order to increase processing time.” (Emphasis added) First, neither the Office Action nor any portion of the Wang disclosure describes how or why processing time would be affected by modifying Wang’s system to incorporate the additional features of claim 50. Second, increased processing time is a universally undesirable characteristic of computing systems, and no stated reason or rationale within Wang supports a modification of the system to increase its processing time. For these reasons, the Office Action has failed to provide an articulated reason for its proposed modification of Wang, and the rejection under 35 U.S.C. § 103(a) should therefore be withdrawn on this basis.

Furthermore, Applicant notes that the proposed modification of Wang is far from minor. Although Wang discloses rules that transform content, it uses entirely separate entities, designers at design consoles (102 or 104), to set the rules for the transformations. See FIG. 1; Col. 6, lines 36-56. The modification of Wang proposed by the Office would essentially eliminate the designers, which are primary focus of the Wang disclosure (see, e.g., FIGS. 6-26). Additionally, Wang’s content transformation occurs at a different time than the converting recited in claim 50, in that Wang is only capable of transforming already existing web pages. See Col. 1, lines 14-15. Thus, Wang has no need or rationale for requesting/receiving device-independent content comprising markup language identifying device feature values, as recited in claim 50. For at least these reasons, Applicant submits that the attempted modification of Wang is impermissible

hindsight. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) based on Wang.

Independent claims 51, 56, and 58 recite similar features not disclosed by Wang. Specifically, claims 51 and 56 recite receiving “device-independent content compris[ing] markup information identifying one or more device feature values associated with the device-independent content,” and claim 58 recites receiving “device-dependent content compris[ing] a modified version of the device-independent content, said modifications based on the type of the apparatus.” The Office Action rejects claims 51 and 56 under 35 U.S.C. § 103(a), using the same attempted modification of Wang and providing the same rationale. With respect to claim 58, as noted above, it is unclear from the Office Action which reference or combination of references allegedly teaches the features of this claim. Accordingly, Applicant requests that the rejections to independent claims 51, 56, 58 be withdrawn for similar reasons to those discussed above, both because the Office Action has provided no articulated reasoning for the attempted modification, and because any such modification constitutes impermissible hindsight.

Independent Claims 52 and 53

Amended claims 52 and 53 recite similar features not disclosed by Wang. Specifically, claim 52 recites receiving content responsive to a content request, “wherein said content comprises markup information identifying one or more content display characteristics,” claim 53 recites receiving “device-independent content responsive to a content request comprising embedded annotations ... for displaying the content on a plurality of devices having different display characteristics, said embedded annotations including one or more content display feature values.” The Office Action rejects claims 52 and 53 under 35 U.S.C. § 103(a) based on Wang, but provides a slightly different reason for the modification (“to eliminate the burden on the proxy server”). Office Action, page 6. Nonetheless, the attempted modification of Wang is impermissible hindsight for the same reasons discussed above regarding claim 50. Accordingly, Applicant requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Wang.

Additionally, amended claims 52 and 53 both relate to rendering content based on the instructions of an author. Specifically, amended claim 52 recites wherein “said content display

characteristics expressing instructions from an author for displaying said content on a plurality of devices having different display characteristics,” and amended claim 53 recites wherein “the device-independent content comprising embedded annotations specifying instructions from an author for displaying the content on a plurality of devices having different display characteristics.” (Emphasis added) As discussed above, in Wang, the transforming and rendering of content is only performed on existing web pages (see col. 1, lines 14-15), based on the work of a designer (FIG. 1, 102) who is a separate entity from the author (FIG. 1, 132). Thus, Wang does not disclose converting content expressing or specifying “instructions from an author,” as respectively recited in claims 52 and 53. As an example to illustrate this distinction, FIG. 3 of Wang shows a ‘result page’ 304 corresponding to a modified view of the YAHOO!® web site that has been customized by a designer. This customized view 304 is different from the YAHOO!® ‘source page’ 302, and clearly does not represent the rendering instructions of the authors of the YAHOO!® web site. Accordingly, amended claims 52 and 53 are allowable over Wang for at least this additional reason.

Dependent Claims

Claims 2-6, 8-14, 17, 20-24, 26, 29-31, 33-41, 43-45, 57, and 59-61 each depend from one of claims 50-53, 56, or 58. Furthermore, since neither Britton, nor Rohrabough, nor Lo cures the deficiencies of Wang discussed above regarding independent claims 50-53, 56, and 58, Applicant submits that each of these dependent claims are allowable for at least the same reasons as their respective base claims, as well as based on the additional features recited therein.

Claim 9

Claim 9 recites, “removing said markup information from said device-independent content.” The Office Action alleges that this feature is taught by Britton at Col. 8, lines 26-37 and Col. 12, lines 20-31. However, as discussed in the Request for Reconsideration dated April 23, 2008, neither the relied-upon sections nor any other section of Britton discloses converting device-independent content by removing markup language. Accordingly, Applicant submits that claim 9 is allowable for at least this additional reason.

New Claims

Applicant has added new claims 62 and 63 to more fully claim the invention. No new matter has been added. Claims 62 and 63 depend respectively from claim 50 and claim 56, and further recite “wherein said matching comprises accessing a device profile repository including feature-value data for a plurality of different types of network terminal devices.” The Office Action on page 14 (in the rejection of claim 20) alleges that Britton discloses a device profile repository at Col. 10, lines 1-21 and Col. 11, lines 1-25. However, these sections do not mention a device profile repository or any equivalent concept, and neither these sections nor any other section of Britton discloses “accessing a device profile repository including feature-value data for a plurality of different types of network terminal devices,” as recited. Accordingly, new claims 62 and 63 are allowable for at least this additional reason.

CONCLUSION

Based on the foregoing, Applicant respectfully submits that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicant’s undersigned representative at the below-listed number.

Respectfully submitted,

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